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Urs Reuteler

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KING & SCHICKLI, PLLC
247 NORTH BROADWAY
LEXINGTON, KY 40507

EXAMINER

HARMON, CHRISTOPHER R

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/532,528
Filing Date: October 07, 2005
Appellant(s): REUTELER ET AL.

Andrew D. Dorisio
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 1/24/09 appealing from the Office action mailed 8/27/08.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

U.S. Application no. 11/872,409.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct. The amendment after final rejection filed on 12/8/08 has not been entered.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

| | | |
|-----------|-----------------|--------|
| 3,187,483 | Steele | 6-1965 |
| 5,638,659 | Moncrief et al. | 6-1997 |
| 5,501,318 | Disrud | 3-1996 |

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Interpretation

As noted in the Non-Final rejection of 3/31/08, pending claims contain limitations (means for conveying, folding, providing, applying or activating) in “means plus function” form and however only the "means for folding" (claim 1 and 109) and arguably “means for providing and conveying along a second leg” (claim 109) meet the analysis set forth in MPEP 2181, for invoking treatment under 35 USC 112, paragraph 6.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 109, 111-112 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellant regards as the invention.

The "support surface for supporting the carton" is not contiguous as one would be ordinarily led to believe by claiming multiple portions of the same surface and then creates confusion how one portion of the surface overlies the other transverse portion.

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The means for conveying the carton along the 1) first portion and 2) to the second end of the first portion of the support surface are claimed as two separate means (claim 109, lines 5-10) however are not clearly the conveyors described in the specification. Note: there is nothing described that conveys a product along the second portion of the support surface (perpendicular to first portion in L-shape) to the second end of the first portion as claimed. The conveyor that conveys products to the second end of the first portion starts at the first end of the first portion, ends at the second end of the first portion, transferring products to the first end of the second portion and means for conveying along the second portion of the support surface.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 109 and 112 stand rejected under 35 U.S.C. 102(b) as being anticipated by Steele (US 3,187,483).

Due to the uncertainty of the claimed limitations and taking the broadest reasonable interpretation of the claims, Steele is considered to disclose each and every element of the claimed device. Steele discloses a machine for folding boxes comprising lug conveyors c and e in an L shaped plan; see figure 1 with a conveyor comprising parallel conveyor chains h, i, 168, and 169 located adjacent and perpendicular to one another; (note conveyor h is an overhead conveyor; see figures 5 and 7) folding

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means/stationary plows 57 and rollers j, k for first and second flaps respectively; adhesive applicator means n; see figure 1. Lugs are considered retracted and upstanding to selectively engage containers. Any conveyor can be read as a “takeaway” conveyor as the conveyors perform a transportation function and take away the products.

Note the means for conveying the carton along the first portion does not meet the analysis under 35 USC 112(6). The means for conveying the carton to the second end, as understood, invokes treatment under 35 USC 112(6), however is anticipated by the takeaway conveyor of Steele. Furthermore the means for folding the flap while also invoking this section is anticipated.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 9, 106-108, 111, and 113 stand rejected under 35 U.S.C. 103(a) as obvious over Steele (US 3,187,483) in view of Disrud (US 5,501,318).

Steele discloses a machine for folding boxes comprising lug conveyors c and e in an L shaped plan providing first and second portions of a product path arranged perpendicular to one another; see figure 1. Steele discloses takeaway conveyor comprising parallel conveyor chains h, i, 168, and 169 located adjacent and perpendicular to one another; folding means/stationary plows 57 and rollers j, k for first

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and second flaps respectively; adhesive applicator means n; see figure 1, 5 and 7.

Lugs are considered retracted and upstanding to selectively engage containers as they travel around cylinders/pulleys into and out of engaging paths.

The first conveyor c which travels along a first portion of the path is not directly disclosed as an overhead conveyor however Steele notes that containers are fed from the closing apparatus "upon a lugged link belt or other appropriate conveyor c" (column 3, lines 56+). Disrud provides an overhead lugged conveyor for conveyance of packaging materials along a surface; see figure 1. It would have been obvious to one of ordinary skill in the art at the time of the invention to include the overhead conveyance system of Disrud in the invention to Steele for providing the cartons along the first portion of the surface for supporting the carton.

Regarding claim 5, Steele describes closing flaps of the container previous to the engagement of the container by lugged conveyor c, see column 3, lines 55+, however does not discuss the device that closes (at least partially) the flaps. As admitted in appellant's response of 5/14/08, rotatable wheels with radially projecting extensions are well known in the art for at least partially closing flaps. It would have been obvious at the time of the invention to close the flaps (at least one partially) of the container of Steele by a rotatable wheel having at least one radially extending projection for closing flaps as the containers passed through the production cycle.

Regarding claims 106 and 108, the conveyor c extends beyond the takeaway conveyor e, therefore an overhead conveyor in the same position would overlie the other as claimed.

Claims 4, 107-108 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Steele (US 3,187,483) in view of Moncrief et al. (US 5,638,659).

While lugs of the conveyors of Steele selectively (via controlled rotation of the drive wheels) pop-up/pivot into and out of the conveying path via rotation, pop-up lugs 63 are known in the art as taught by Moncrief et al. It would have been obvious to one of ordinary skill in the art to use pop-up lugs as taught by Moncrief et al. in the invention to Steele in order to further the transport of the containers when desired.

(10) Response to Argument

Appellant's arguments filed 1/24/09 have been fully considered but they are not persuasive. Note appellant describes the support surface having an L-shape with a first and second portion aligned perpendicularly. The means for conveying are conveyors along each portion. The claimed limitations do not correspond with conveyors as described in the specification; as noted supra. Note that during patent examination, the pending claims must be interpreted as broadly as their terms reasonably allow. *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 320,322 (Fed. Cir. 1999). In determining the patentability of claims, the PTO gives claim language its broadest reasonable interpretation" consistent with the specification and claims. *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). See MPEP § 904.1. Limitations not appearing in the claims cannot be relied upon for patentability; *In re Self*, 671 F.2d 1344, 1348 (CCPA 1982). Particular embodiments appearing in the written description are not to be read into the claims if the claim language is broader than the embodiment; see *Superguide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875 (Fed.Cir. 2004).

Regarding the rejection under 35 USC 102, Steele discloses each and every element as claimed. Due to the indefiniteness of the claims, as noted supra, one cannot distinguish the relationship between elements of claims. It would seem that both means for conveying would be the overhead conveyor as it conveys products along the first portion and to the second end of the first portion. The takeaway conveyor does not convey products to the second end of the first portion as claimed. Note that conveyor h is an overhead conveyor which at least partially overlies a second portion of the path along a second portion of the support surface. Takeaway conveyors are also provided by Steele.

Regarding the combination of Steele and Disrud, note that a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond that person's skill. While evaluating obviousness, one must ask whether the improvement is more than the predictable use of prior-art elements according to their established functions; see *KSR Int. v. Teleflex 550 US__* (2007).

To determine whether there was an apparent reason to combine the known elements in the way a patent claims, it will often be necessary to look to interrelated teachings of multiple patents; to the effects of demands known to the design community or present in the marketplace; and to the background knowledge possessed by a person having ordinary skill in the art; *ibid.*

The analysis need not seek out precise teachings directed to the challenged claimed specific subject matter, for a court can consider the inferences and creative

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steps a person of ordinary skill in the art would employ. Under the correct analysis, any need or problem known in the field and addressed by the patent can provide a reason for combining the elements in the manner claimed; *ibid.* Steele directly suggests using a variety of conveyors for conveyor c; see column 3, lines 56+. Various reasons exist for using conveyors of differing types including the type of carton hopper used ie. top load, bottom load, etc., speed of the conveyor desired, weight of the carton, etc. One of ordinary skill in the art would look to other types of conveyors to transport the cartons to the transfer point.

Regarding pop-up lugs, lugs on a chain conveyor function to pivot or “pop up” as they round the end gearing system of the conveyor in order to enter into an engagement path with a product, as evidenced by the prior art. Each chain link pivots with respect to one another. Therefore the lugs are considered to be pivotally mounted. Selective control of the lugs to “pop-up” at a desired time, however requires further complexity not necessarily present in the teachings of Steele. Disrud is therefore relied upon for evidencing a known manner of accomplishing this control. One of ordinary skill would have been fully capable of looking to Disrud for a conveyor of a known type to be used in the invention to Steele (as expressly suggested by Steele); as noted above.

Furthermore, one of ordinary skill in the art would easily recognize the use of the control system actuators of Moncrief et al. for increased performance for transportation of the cartons in the invention to Steele et al. The lug actuator system would allow for a “smart” automated system wherein the lugs would be controlled by the actuators for various reasons including predictable events that might occur such as a carton jam,

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missing/damaged lug on one conveyor but not the other, etc. The lug actuator system would function in a predictable manner as taught by Moncrief et al. One of ordinary skill in the art could easily provide the lugged belt and actuation means (ie. diverter, motive device, etc.) in the invention to Steele for providing the selective transport of the products and would function in a predictable manner.

Note: it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70; “section 103 cannot easily be satisfied by inventions that rearrange old elements in new combinations with each element performing the same function it performed in the prior art, even though the new combination produces a more striking result than the old ones. *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273 (1976). Presenting known conveyors for transporting cartions in an overlying relationship is not considered a novel concept. One of ordinary skill in the art would easily recognize the advantages of positioning conveyors in various configurations.

(11) Related Proceeding(s) Appendix

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,
/Christopher R Harmon/
Primary Examiner, Art Unit 3721

Conferees:

/Henry Yuen/
Special Programs Examiner, TC 3700

/Louis K. Huynh/
Primary Examiner, Art Unit 3721